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#13/Reply
Brief
4/4/03
V. Hart

In re the PATENT application of

Ernie L. Deacon et al.

Examiner: Patterson, M.

Serial No.: 10/039,338

Group Art Unit: 3728

Filed: October 29, 2001

For: Golf Shoe Cleat

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

TRANSMITTAL LETTER

Sir:

Transmitted herewith for filing in the subject application are Three copies of Reply Brief
(8 pages each).

The Commissioner is hereby authorized to charge payment of any additional fees required
for the above-identified application or Assignment or credit any overpayment to Deposit Account
No. 05-0460.

Respectfully submitted,

Ira C. Edell
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Hand-delivered: 3-31-03

Noted
4/7/03
mdp

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the PATENT application of

Ernie L. Deacon et al.

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REPLY BRIEF

Hon. Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

This Reply Brief is filed pursuant to 37 C.F.R. § 1.193(b)(1), in triplicate, in response to statements made in the Examiner's Answer mailed January 31, 2003.

In view of the arguments and supporting authorities set forth below and in Appellants Brief filed on January 14, 2003, the Board of Patent Appeal and Interferences (BPAI) should find the rejections of claims 18 – 34 to be in error and should reverse those rejections.

1. The rejection 35 U.S.C. §112, first paragraph

The position of the Examiner in making this rejection is that Appellants have disclosed in the original application only "ribs" to provide traction "with no mention whatsoever of any alternatives or equivalents thereof at the time of filing the application". (Emphasis added; See Examiner's Answer, Page 3, last paragraph, continuing on Page 4). The Examiner then concludes that one of ordinary skill in the art would not have been informed "of appellants' interest in or possession of

equivalents, now claimed as part of the means plus function recitation". This, concludes the Examiner, effectively adds new matter to the disclosure.

In rebuttal, it must first be stated that Appellants, as pointed out in Appellants' Brief, Page 10, have disclosed a variety of equivalents in the original application. Such disclosure notwithstanding, the following addresses the propriety of the rejection as a matter of law.

35 U.S.C. §112, first paragraph, requires that an applicant "set forth the *best mode* contemplated by the inventor of carrying out his invention". Note that there is no requirement to set forth alternative or equivalent modes, only the *best mode*. It is in this context that 35 U.S.C. §112, sixth paragraph, requires a "means plus function" limitation to "be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof". Note that there is no time limit placed on when the "means plus function" limitation may be added. These two paragraphs of the same statute section can only make sense and be mutually consistent if an applicant is entitled to claim his/her invention in "means plus function" format to be interpreted more broadly than the specific embodiment(s) disclosed. This is true because the disclosure of even a single means for performing a claimed function constitutes support in the disclosure for the broadening "means plus function" limitation.

The Examiner's attempt to apply a temporal factor to this aspect of the law is, with respect, nonsensical, and it is most certainly contrary to case law authority. The Examiner's position is that the addition of such a limitation after the filing date of an application should be treated differently than the same limitation if presented in the

original application. Appellants have consistently requested that supporting authority be cited and none has been provided.

As noted above, the Examiner bases her allegation of lack of disclosure of equivalents on her belief that "one skilled in the art, reading the original disclosure, would not have been informed of appellants' interest in or possession of equivalents now claimed as part of the means plus function recitation". (See Examiner's Answer, paragraph overlapping pages 3 and 4). How in the world would someone of ordinary skill in the art be more "informed of appellants' interest in or possession of equivalents" if the means plus function recitation were presented in the original application than if the limitation is first submitted during prosecution? A "means plus function" limitation *per se* does not specify any alternative or equivalent structure or function. What more than is already in the specification would the skilled artisan learn from the "means" limitation when it is in the original application? If the Examiner's logic is extended through its natural course, no "means plus function" limitation in an original claim (i.e., a claim in the application as filed) would be permitted if only a best mode, without equivalents, is disclosed in that application. Clearly, that is not the intent behind section 112, and the courts and this Board have so recognized. For example in *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1006 (CA FC 2001), the Court stated:

"Drafters of means-plus-function claim limitations are statutorily guaranteed a range of equivalents extending beyond that which is explicitly disclosed in the patent document itself: An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, *and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.*" (Emphasis in original).

This is consistent with the long established rule of *In re Sweet*, 393 F.2d 837, 841-42, 157 USPQ 495, 499 (CCPA 1968) where the Court stated:

"[A] recitation of "means" for performing a function is interpreted broadly to cover all means capable of performing the stated function and *is not limited to the particular structure which the application may disclose* ." (Emphasis added).

This statement in the *Sweet* decision was considered by the CAFC in *In re Iwahashi*, 12 USPQ2d 1908, 1912 FN1, (Fed. Cir. 1989) as follows:

"This statement, considered in a vacuum, is partly true and partly untrue. It must be read, however, in light of the opinion as a whole. It should not be removed from its context. The untrue part is the initial statement that the means clause is interpreted to cover *all* means to perform the function. It should have said it is interpreted to cover the means disclosed and all equivalents thereof which perform the function. The immediately preceding two paragraphs of the opinion show that the court actually was reading the "means" clause "in the light of 35 U.S.C. 112 [last paragraph]," just as we are doing here. The statute is set forth in note 5. The truth of the emphasized portion of the above sentence is beyond question because the "means" clause includes equivalents of the disclosed structure. Section 112 ¶6 cannot be ignored when a claim is before the PTO any more than when it is before the courts in an issued patent." (Italics in original; underlining added for emphasis).

It is noted that the Court in *Iwahashi* said that it is beyond question that a "means" clause is interpreted to cover the means disclosed and all equivalents thereof which perform the function, and that Section 112 ¶6 cannot be ignored when a claim is before the PTO. The Court does not say or even hint that a "means" claim can be ignored if it is not presented with the original application.

What the Examiner has failed to realize in propounding her novel position is that "equivalents" are determined not at the time of filing an application but at the time of infringement. As stated by this Board in *Ex parte Isaksen*, 23 USPQ2d 1001, 1013 (BPAI 1992):

"It is not required that those skilled in the art knew, at the time the patent application was filed, of the asserted equivalent means of performing the claimed functions; that equivalence is determined as of the time infringement takes place. If pending means claims were interpreted as limited to disclosed means and equivalents thereof, patent applicants would have to prosecute based on what they predict to be or not to be equivalent in the future. That is impractical, if not nonsensical, because equivalence is determined "as of the time infringement takes place". (Quotation in original).

In support of her position, the Examiner (at Page 9, lines 9 – 10 of the Examiner's Answer) states, a bit disingenuously to advocate her position, that she "is at a loss as to what structures would be considered to be equivalents" of the traction means. Does this Examiner, who has examined scores of cleat patents disclosing all sorts of traction means, expect this Board to believe that? Clearly, this Examiner is skilled in the art and is making such statements in an attempt to support a legally unsupportable position that has been forced upon her by the BPAI in the rejection made on the BPAI's own initiative in Appeal No. 1999-2103 concerning Appellants' parent application. The technology involved in this issue is not rocket science; rather, we are dealing with traction means, means for providing traction. Not to belittle cleat technology in general, but traction is a concept familiar to first year engineering students. Even without the benefit of all of the cleat-related applications that this Examiner has examined, can the Examiner honestly state that, armed with Appellants' disclosure, she could not conceive an equivalent structure to that disclosed by Appellants for providing traction means on a cleat? Even as of the original application filing date? This is even more difficult to believe when one considers that, as indicated by the BPAI in *Isaksen*, equivalents are determined at the time infringement takes place, not at the time an application is filed.

As previously noted, there is no case law or other authority that even remotely supports the Examiner's position that a "means" claim, added after filing an application in which only one embodiment is disclosed, constitutes new matter. If this Board sustains the Examiner's position, the Board will be blazing new trails and, in so doing, will effectively retrospectively invalidate hundreds, if

not thousands, of claims in extant patents allowed by the USPTO, many of which have received the blessing of the BPAI. In addition to original patents, broadened re-issue claims, where "means" limitations were submitted for the first time in a re-issue application to more broadly cover features that were disclosed without express disclosure of equivalents, would be invalidated retrospectively by sustaining this rejection.

The Examiner states that she has reviewed the case law cited by Appellants but finds the decisions and opinions to be non-persuasive. The Examiner dismisses cogent authority cited by Appellants with the hackneyed, last resort argument that new matter issues are tied to the specific facts of each case. Does that relieve the Examiner of the burden of citing *some* authority, *any* authority, to support her truly revolutionary position?

For these reasons, and the reasons stated in Appellant's Brief on Appeal, it is submitted that this rejection is improper.

2. The rejection 35 U.S.C. §112, second paragraph

The Examiner states that because the equivalents covered by the means-plus-function claims are not specifically described, the scope of the claim is indefinite under 35 U.S.C. §112, second paragraph. This is contrary to the provision in M.P.E.P. §2174 which states:

"If a description or enabling disclosure is not commensurate in scope with the subject matter encompassed by a claim, that fact alone does not render the claim imprecise or indefinite or otherwise not in compliance with 35 U.S.C. 112, second paragraph; rather, the claim is based on insufficient disclosure."

For this reason, and the reasons stated in Appellant's Brief on Appeal, it is submitted that this rejection is improper.

3. The Prior Art Rejection.

Beginning at the middle of page 11 of the Examiner's Answer, the Examiner begins to extrapolate concepts from the Jordan (3583082) disclosure that are clearly based on hindsight derived from Appellants' disclosure. Jordan describes his cleats as "suited for use on composition tracks or other modern surfaces formed of natural synthetic materials". (Jordan, column 1, lines 45 -47). Then at column 2, lines 1 – 4, Jordan states that the cleats "are specifically designed for use in conjunction with modern track surfaces which may be formed of composition materials, synthetic turf, or other variations of natural and synthetic materials." (Emphasis added). It is notable that Jordan took pains to state *synthetic* turf to distinguish over "turf" alone, and did not mention or suggest *natural* turf. It is also notable that Appellants' claims recite *golf* turf. The Examiner points to a statement by Jordan at column 2, lines 63 – 69, to the effect that since "different track surfaces will, however, undoubtedly be encountered by individual runners, the spikes are preferably removable so that variation can be employed". The Examiner then considers "turf" to be one such track surface. With respect, this conclusion is a quantum leap in logic and not justified. In this quoted section of the patent Jordan is talking about the replacement capability of the cleats but is not broadening the types of surfaces on which they are or can be used; the particular various surfaces are described elsewhere in the patent, as noted above, as composition materials, synthetic turf, or other variations of natural and synthetic materials, not golf turf or natural turf. As pointed out in great detail in Appellants' Brief on Appeal, the bristles 18 of Jordan would penetrate golf turf, and Jordan suggests no alternative structure that would prevent such penetration. The simple fact is that Jordan's spike is designed for use on hard running tracks, not golf turf, and nothing in the Jordan disclosure would have suggested to one of ordinary skill in the art at the time of Appellants' invention how to use the Jordan spike on golf turf without penetrating that turf.

For this reason, and the reasons stated in Appellants' Brief on Appeal, it is submitted that this rejection is improper.

4. Conclusion

In view of the foregoing it is submitted that the rejections of claims 18 - 34 are improper and should be reversed.

Respectfully submitted,



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